

## REMARKS

Claims 1-30 are pending in the present application. Claims 1-30 were subjected to a restriction requirement on June 10, 2002, from which claims 1-14 and 27 were selected.

Accordingly, claims 15-26 and 28-30 were withdrawn from consideration. Of the selected claims, claims 1, 2, 6, 10-14, and 27 stand rejected. Claims 3-5 and 7-9 were objected to.

### **I. Rejections Under 35 U.S.C. § 102(b)**

Claims 1, 2, 6, 10, 11, 14, and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by New Zealand Patent Publication No. 299114 issued to Enviropod New Zealand Limited ("Enviropod"). In particular, the Examiner states that "Enviropod discloses an apparatus and a catch basin filtration system comprising:... (c) an initial high flow bypass, seen as outlet (14) in Fig. 1..., and (d) a secondary high flow bypass, seen as overflow opening (13) in Fig. 1." Applicants respectfully submit that Enviropod fails to anticipate the cited claims.

In order to anticipate a claim, a reference must include every material element of that claim. Independent claims 1 and 27 recite, *inter alia*, "(c) an initial high flow bypass situated within [a] filter body support" and "(d) a secondary high flow bypass." Applicants respectfully submit that neither of these elements is found in Enviropod. Enviropod's "outlet (14)" to the storm water drain is distinguishable from the claimed initial high flow bypass, in that the outlet disclosed in Enviropod does not provide for a high flow bypass, initial or otherwise. As the Examiner correctly notes in the Final Office Action dated January 28, 2003, in Enviropod's filtration device "the water will first, initially flow out of the outlet (14) when the water level rises." See Final Office Action at page 6. Thus, this initial flow out of the outlet (14) in Enviropod does serve as a "bypass," as that term is used and claimed in the present invention.

Further, as shown in Figure 1, Enviropod's "overflow opening (13)" reflects a curb inlet to the storm water drain. This curb inlet is depicted as an opening that provides a means of fluid entry into the storm water drain. It is distinguishable from the claimed initial high flow bypass, in that the curb inlet does not provide any overflow or "bypass" with respect to the installed filtration means of the claimed invention. Examination of Enviropod's discussion of "overflow" also supports this position. Specifically, Enviropod states that "[w]hen inflow exceeds outflow, the water level in the bag slowly rises until flow bypasses through the overflow." *See* Enviropod at page 11, lines 10-11. Enviropod does not specify the exact location of this overflow nor does the recitation of this single "overflow" provide for both initial and secondary high flow bypasses "whereby said secondary high flow bypass passes excess fluid only after excess fluid has passed or attempted to pass through said initial high flow bypass," as recited in claim 2 of the instant application.

For at least the foregoing reasons, Enviropod fails to include every material element of independent claims 1 and 27. Since dependent claims 2, 6, 10, 11, and 14 depend from independent claim 1, Enviropod similarly fails to anticipate these claims for at least the same reasons. Thus, Applicants respectfully submit that claims 1, 2, 6, 10, 11, 14, and 27 are patentable over Enviropod and thus respectfully requests withdrawal of the Examiner's rejection.

## **II. Rejections under 35 U.S.C. § 102(e)**

Claims 1, 2, 6, 10-12, 14, and 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,093,314 issued to Wilson et al. ("Wilson"). In particular, the Examiner states that "Wilson discloses an apparatus and a catch basin filtration system comprising:... (c) an initial high flow bypass, seen as outlets (30) in Figs. 1 and 2..., and (d) a

secondary high flow bypass, seen as grating (57) in Fig. 3.” Applicants respectfully submit that Wilson fails to anticipate the cited claims.

As noted above, in order to anticipate a claim, a reference must include every material element of that claim. Independent claims 1 and 27 recite, *inter alia*, “(c) an initial high flow bypass situated within [a] filter body support” and “(d) a secondary high flow bypass.” Applicants respectfully submit that neither of these elements is found in Wilson. According to Wilson, during operation water fills the interior of the drain insert. *See* Wilson at column 4, lines 23-36. The water is then discharged through the outlet openings in the usual direction of flow. *See id.* at column 7, lines 32-46. Thus, the permanently formed “outlets (30)” in Wilson do not provide an initial high flow “bypass,” as that term is used and claimed in the present invention. Similarly, the “grating (57)” in Wilson shows an inlet to the drain insert, rather than a “secondary high flow bypass.” As the Examiner correctly notes in the Final Office Action dated January 28, 2003, “... when the water entirely fills the drain insert, it will spill up through the grate (57).” *See* Final Office Action at page 8. This spillage fails to allow for the secondary bypass flow of “excess fluid after excess fluid has passed or attempted to pass through said initial high flow bypass,” as recited in claim 2 of the instant application.

For at least the foregoing reasons, Wilson fails to include every material element of independent claims 1 and 27. Further, since claims 2, 6, 10, 11, and 14 all depend from independent claim 1, Wilson fails to anticipate these claims for at least the same reasons. Applicants thus respectfully submit that claims 1, 2, 6, 10, 11, 14, and 27 are patentable over Wilson, and respectfully requests allowance of these claims.

### **III. Rejections under 35 U.S.C. § 103**

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson. In particular, the Examiner states that “[t]he single filter (44) of Wilson can be viewed as an elongated boom.” The Applicants respectfully submit that the Office Action fails to set forth a prima facie case of obviousness.

The Office Action fails to set forth the suggestion or motivation to make the modification advanced as the basis for the obviousness rejection. Absent some suggestion in the art, there is no support for the rejection advanced. Wilson provides for a filter “supported by a pair of hooks” (in a preferred embodiment), that “rests atop the surface 74 of the water within the drain insert 10.” See Wilson, column 5, lines 42-50; column 7, lines 56-59. The filter is depicted as a “pillow” in Figure 2 of Wilson that substantially covers the cross-section of flow to absorb gasoline, oil, grease, and the like. This “pillow” substantially covering the cross section of flow, however, is distinguishable from the elongated booms claimed in the present invention. There is no suggestion in Wilson to make the modification suggested in the Office Action. Accordingly, Applicants respectfully submit that the Office Action fails to set forth a prima facie case of obviousness and therefore claim 13 is patentable over Wilson for at least the foregoing reasons. It is respectfully requested that the Examiner withdraw this rejection.

### **CONCLUSION**

Applicants respectfully submit that all claims are in proper form and condition for patentability, and requests a notification of allowance to that effect. Outside the fee for the Extension of Time Petition and the fee for the Request for Continued Examination, it is believed

that no other fee is due at this time. Should any fee be required for any reason related to this document, however, the Commissioner is authorized to charge said fee to Deposit Account No. 08-3038, referencing Docket No. 11533.0012.CPUS04. The Examiner is hereby respectfully invited to contact the undersigned attorney with any questions, comments or suggestions relating to this application.

Respectfully Submitted,

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